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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,711	09/12/2003	Kristin Parshall	0876-0061	8228
47050	7590	04/07/2006	EXAMINER	
RYNDAK & SURI LLP 200 W MADISON STREET SUITE 2100 CHICAGO, IL 60602			PRATT, HELEN F	
			ART UNIT	PAPER NUMBER
			1761	

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/661,711

Applicant(s)

PARSHALL ET AL.

Examiner

Helen F. Pratt

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1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-38 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 9 of copending Application No. 2005/0058763 A1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application encompasses the limitations of 1 and claim 9.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 112***

Claim 31 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

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regards as the invention. Claim 31 is indefinite in the use of the phrase "and maintaining selected flavor sensory attributes". It is not known which flavor attributes applicants are referring to.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 8-11, 13-16, 30-35, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (6,162,474) or Ford et al. (5,607,707) in view of Nawar (6,641,847).

Chen et al. disclose a beverage composition containing orange juice and vitamin E or its esters (col. 17, lines 40-43, col. 24, lines 5-9 and abstract). Ford et al. discloses a beverage composition containing orange juice and alpha tocopherol (col. 7, lines 20-35 and col. 8, lines 40-70 and col. 14, lines 11-13). Claim 1 differs from the reference in the use of other tocopherols than the alpha form. However, the reference to Chen et al. disclose that other esters of tocopherol can be used. Nawar discloses that the other formulas as claimed of tocopherol are known (col. 10, lines 29-35). The reference discloses that the extract of tocopherol can be used in water-based foodstuffs such as juice drinks. Orange juice in particular has been disclosed by Chen et al. with vitamin E. or its esters. The stabilizing effect of alpha tocopherol has been shown by Ford et al. Therefore, it would have been obvious to substitute the composition of

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Nawar for the tocopherol of Chen et al. or Ford et al. for its art recognized function as an antioxidant particularly as in Ford et al. because tocopherol is shown as a stabilizer of color.

Claims 2-4 require particular amounts of tocopherol. The discovery of an optimum value of a result effective variable is ordinarily within the skill of the art. In re Boesch, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980). In developing a beverage product, properties such as preservation and flavor are important. It appears that the precise ingredients as well as their proportions affect the preservation and flavor of the product, and thus are result effective variables, which one of ordinary skill in the art would routinely optimize.

Claim 5 further requires particular other tocopherols. Nawar discloses such (col. 35, lines 18-22). Therefore, it would have been obvious to use other known tocopherols in the process of Chen et al. for their art known antioxidant functions.

Claim 7 further requires that the tocopherol is added in liquid form. However, no weight is given to process limitations in a composition claim. Nawar discloses the composition as containing oil, which contains tocopherol (col. 35, lines 4-19). Oil is considered to be a liquid. Therefore, it would have been obvious to use tocopherol in a liquid form.

Claim 8 further requires that the tocopherol contains various amounts of the different types of the vitamin. However, applicants' specification discloses that compositions are available with the claimed tocopherol. Nothing is seen that the amounts found in this known composition are not as claimed. Therefore, it would have

been obvious to use known tocopherol compositions in the claimed composition, which contain the claimed amounts of tocopherols.

Claim 9 further requires the use of an edible, claim 10 particular oils and claim 11 that the composition contains 20-80% oil. Nawar discloses the use of oil in the composition, which is from cranberry seed (col. 36, lines 3-10). The particular source of the oil is not given weight absent a showing of unexpected results using that source of oil. Nothing is seen that the composition does not contain the claimed amount of oil. Therefore, it would have been obvious to use a composition, which contains oils in the claimed amounts with tocopherols in the composition of Chen et al.

Claim 13 further requires particular juices such as orange juice, claim 14 "not from concentrate orange juice" (NFCO), and claim 15 juice from concentrate, and claim 16 particular amounts of orange juice. Chen et al. disclose the use of orange juice and full strength juice (col. 17, lines 40-65). The other types of juice are well known, and are generally reconstituted to make a full strength juice. Therefore, it would have been obvious to use known types of juice to with the composition of Chen et al.

The limitations of claims 30, 34, and 37 have been disclosed above and are obvious for those reasons. Claim 31 further requires that the beverage is stored for four weeks and maintains selected flavor sensory attributes during this time. As the method has been shown, the composition would have the claimed attributes. Therefore, it would have been obvious to make a beverage as in claim 30 and 31.

Claim 32 further requires pasteurizing the citrus juice after adding the tocopherol composition and claim 33 pasteurizing before adding the tocopherol composition.

However, nothing new is seen in pasteurizing any liquid which contains germs, which is routine in the trade or in pasteurizing before or adding the tocopherol composition, as tocopherols are heat stable, and would not have been affected one way or the other. Therefore, it would have been obvious to pasteurize at any point in the process and still maintain the stability of the tocopherols.

Claim 35 further requires premixing the tocopherol composition with oil and then adding the mixture to a citrus beverage. However, nothing new is seen in adding one fat-soluble composition such as a tocopherol to another fat. The use of citrus oils as flavorants is well known. Therefore, it would have been obvious to add fat- soluble ingredients to fat and then to add the known citrus oil to a citrus beverage.

***Allowable Subject Matter***

Claims 6, 7, 12, 36, 38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and with a terminal disclaimer.

Claims 17-29 are allowable over the prior art with a terminal disclaimer.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen F. Pratt whose telephone number is 571-272-1404. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Milton Cano, can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hp 4-4-06

  
**HELEN PRATT**  
**PRIMARY EXAMINER**